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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/821,534      | 04/08/2004  | Boris Bernards       | BERNAR-40085        | 1300             |

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EXAMINER

HOGAN, JAMES SEAN

ART UNIT PAPER NUMBER

3752

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                 |  |
|------------------------------|-------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/821,534 | Applicant(s)<br>BERNARDS, BORIS |  |
|                              | Examiner<br>James S. Hogan    | Art Unit<br>3752                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6, 7 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed July 10, 2006 have been fully considered but, with the exception of claims 6, 7 and 9, they are not persuasive. The argument over whether or not the Green et al reference teaches a conical shape or a concave shape is moot. Both shapes perform the exact same functionality, leading the Examiner to conclude that any claimed difference between the two would be an art recognized equivalent, and not subject to any patentability. Further, the limitation of a horizontal lip extending outwardly in claim one is still perceived as met by the Green et al reference. As to the limitation provided with the horizontal wall, to support "the shield adjacent a sprinkler head without attachment thereto", the Examiner will still rely on the reference taught by Hough, which teaches a "notch" (central hole 28) without any specific attaching means or designs, merely an over-sized hole, which would clearly, meet the limitation that it is not attached to a sprinkler head, thereby meeting the claimed limitation. Further, it is noted that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. As to the ambiguity of whether a hole is a notch, the Examiner points to the Applicant's own figures, which in Figures 1-7, the reference numeral 16 alludes to a notch, and wherein the notch of Figure 1 includes a central hole, therefore the reference meets the claimed interpretations

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,830,434 to Green et al. in view of U.S. Patent No. 5,918,814 to Hough

Green et al. teaches a sprinkler head shield comprising a conical inwardly sloping wall defined by a partially circular, single-piece curved plate (30), a lip extending horizontally away from the wall along an upper perimeter thereof (31). Green does not portray the sloping inwards wall as concave, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the inward walls concave since the Examiner understands that it reasonable to construe the equivalence of a conical inwards wall to be a concave inward wall for its use in the sprinkler shield art and the selection of any of these known shapes would be within the level of ordinary skill in the art. Green et al does teach a notch (central hole 33) located substantially near a lower perimeter of the sloping walls, but not configured to accommodate movement of the sprinkler head relative to the plate. Hough teaches a notch (central hole) of no specific diameter and having anchoring means to (12) for "retaining the body (of the sprinkler shield) about a sprinkler head" with no mention of

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frictionally engaging the sprinkler head in any way, thus permitting movement of the sprinkler head relative to the plate. Hough teaches apertures (23) along a sloping wall spaced about a sloped wall. As for claim 3, the mounting system of Hough, which utilizes spikes (60) mounted through apertures (23) in the wall, can substitute for the integrated spikes found on the shield of Green et al., and as per claim 4, uses spikes that include a head (61) made larger than the aperture. As per claims 5, the notch of Green et al is centrally located with the respect to the shield, and the walls slope inwardly towards the notch. It would have been obvious to one skilled in the art at the time the invention was made to have modified the shield of Green et al with the sprinkler-accommodating centrally-located notch and the apertures and spikes of Hough in order to create a sprinkler shield that can be held stationary in view of a rotating sprinkler with an anchoring system with external fasteners that would be more economical to manufacture, as it is easier to fabricate holes in a formed piece rather than forming extensions.

#### ***Allowable Subject Matter***

Claims 6, 7 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Hogan whose telephone number is (571) 272-4902. The examiner can normally be reached on Mon-Fri, 7:00a-4:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Scherbel can be reached on (571) 272-4919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSH  
8/6/2006

A handwritten signature in black ink, appearing to read 'Dinh Q. Nguyen', with a stylized, flowing script.

**DINH Q. NGUYEN  
PRIMARY EXAMINER**